

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVE ZAMPELLA
and
ROBERT E. CASKEY

Appeal No. 96-3520
Application 08/260,563¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, and ABRAMS
and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed June 16, 1994.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1 through 7, 9 and 10 as amended subsequent to the final rejection in a paper filed April 27, 1995 (Paper No. 7).² Claims 11 through 17, the only other claims remaining in the application, stand withdrawn from further consideration under 37 CFR § 1.142(b) as not being directed to the elected invention. Claim 8 has been canceled.

Appellants' invention relates to a steel drum for transporting materials. As noted on page 2 of the specification, it is an object of the invention to provide a 55 gallon steel drum which will fit four abreast in an ISO shipping container with minimum bracing in the ISO container. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim, as it appears in the Appendix to appellants' brief, is attached to this decision.

² Notwithstanding remand of this application to the examiner for, inter alia, entry of the amendment filed April 27, 1995 (see Paper No. 15), we note that the changes requested in claims 1 and 2 of the application in that amendment have still not been clerically entered.

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The prior art of record relied upon by the examiner in rejecting the appealed claims under 35 U.S.C. § 103 is:

Snyder et al. (Snyder) 4,257,527 Mar. 24, 1981

The admitted prior art steel drum seen in Figure 1 of the application drawings.

Claims 1 through 7, 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over admitted prior art Figure 1 in view of Snyder. According to the examiner,

[i]t would have been obvious to substitute for the rolling hoops [of Figure 1], roll loops [sic, hoops] with flattened outer surface as shown by Snyder et al to further improves [sic] the reinforcement on the side wall as shown by Snyder et al. (answer, page 3).

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection of the appealed claims under 35 U.S.C. § 103 cannot be sustained. Our reasons follow.

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A rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. The examiner may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The proper test for obviousness is what the combined teachings of the references would have suggested to those having ordinary skill in the art. See Cable Electric Products, Inc. v. Genmark, Inc., 770 F.2d 1015, 1025, 226 USPQ 881, 886-887 (Fed. Cir. 1985); In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). The law followed by our court of review, and thus by this Board, is that "[a] prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary

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skill in the art." In re Bell, 991 F.2d 781, 783, 26 USPQ2d
1529, 1531

(Fed. Cir. 1993)(quoting In re Rinehart, 531 F.2d 1048, 1051,
189 USPQ 143, 147 (CCPA 1976)).

In this case, essentially for the reasons stated by appellants in their brief (pages 3-5) and reply brief, we find that the examiner's rejection of claims 1 through 7, 9 and 10 under 35 U.S.C. § 103 is not sustainable. Like appellants, we are of the opinion that the examiner has inappropriately relied upon hindsight and improperly used appellants' own disclosure and teachings as a guide through the prior art in selectively modifying the prior art steel drum of Figure 1 of the application in light of the teachings of Snyder's plastic drum so as to arrive at the claimed subject matter. Contrary to the examiner's statement on page 4 of the answer, Snyder does not in any way teach one having ordinary skill in the art "to apply such flattened hoops to a steel drum" (emphasis added). The entirety of the disclosure and teachings of the Snyder patent relate to a

rotationally molded, high density, cross-linked polyethylene plastic drum.

Moreover, even if such a modification as suggested by the examiner were made in the steel drum of admitted prior art Figure 1, it is totally speculative on the examiner's part that such a modification of the prior art steel drum would provide improved reinforcement of the sidewall of the steel drum and result in a steel drum inherently possessing the other characteristics required in appellants' claim 1 on appeal. In this regard, we note that such a retrospective view of inherency is not a substitute for some teaching or suggestion in the prior art which supports the selection and use of the various elements of the prior art in the particular claimed combination. See In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); In re Newell, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Given that we have concluded that the examiner has not established a prima facie case of obviousness, we find it

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unnecessary to comment on appellants' evidence of nonobviousness in the form of the declaration of Philip D. Bartlett, filed April 27, 1995.

Based on the foregoing, the decision of the examiner rejecting claims 1 through 7, 9 and 10 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
)	
)	
NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
CHARLES E. FRANKFORT)	

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Administrative Patent Judge)

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APPENDED CLAIM

1. A drum comprising

a cylindrical steel body having a height and a diameter and including an upper rolling hoop and a lower rolling hoop, each of said rolling hoops having a substantially flattened outer surface and a diameter at said outer surface of not more than about $2\frac{3}{4}$ inches;

a steel head; and

a steel bottom

wherein the diameter of the cylindrical steel body is constant with the exception of the area of the rolling hoops and further wherein the rolling hoops are deformable from a circular configuration to an elliptical configuration when squeezed into an area adjacent a like drum, with said flattened areas of adjacent rolling hoops contacting each other as bearing surfaces.